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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,820	12/13/2001	Kin-Ping Wong	AN 2004.00	5971

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McCutchen Doyle Brown & Enersen LLP  
Suite 1800  
Three Embarcadero Center  
San Francisco, CA 94111-4067

EXAMINER

LILLING, HERBERT J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,820

Applicant(s)

WONG, KIN-PING

Examiner

HERBERT J LILLING

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05-09-2002; 06-24-2002 and 07-30-2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Receipt is acknowledged of the correspondence filed May 09, 2002, prior art information disclosure statement filed June 24, 2002 and the preliminary amendment filed July 30, 2002.

2. Claims 1-36 are pending in this instant application.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to a compound having a molecular weight of 18kD to about 20 kD having characteristics consistent with a protein and a pharmaceutical composition, cannot be properly classified due to lack of suitable information as to the structure of the compound or positive identifying properties. These claims cannot be examined with respect to art but would be rejected based on non-art.
- II. Claim 3,7, drawn to a mixture, which cannot be properly classified due to the above same problems.
- III. Claims 4, 8, 12, 13, 16, 19 drawn to a process of obtaining an extract of *Tricholoma Conglobatum* ETCa, ECTb, ATC07alpha or beta, classified in Class 424, 195.15.
- IV. Claims 5, 6, 9, 10, 14, 17, 20 drawn to an extract prepared by the specific processing of *Tricholoma Conglobatum* and pharmaceutically acceptable carriers, classified in Class 424 or 514, depending upon the extract per se.

- V. Claim 11, 15, 18, 21 drawn to a mixture, classified in Class 424 or 514 and numerous subclasses depending upon the extract per se and the additional agent.
- VI. Claim 22, 24, drawn to a method of using the extracts of prepared by the specific processing of *Tricholoma Conglobatum* and pharmaceutically acceptable carriers to inhibit the growth of endothelial cells or vascularization in a tissue, classified in Class 424 or 514, subclasses depending upon the extract per se.
- VII. Claim 23, 25, drawn to a method of employing a mixture of extracts of prepared by the specific processing of *Tricholoma Conglobatum* and pharmaceutically acceptable carriers to inhibit the growth of endothelial cells or vascularization in a tissue, classified in Class 424 or 514, subclasses depending upon the extract per se.
- VIII. Claim 26, 30, 31, 32, 33, drawn to a method of treating a disorder associated with pathological neovasularization or endothelial cell growth by using the extracts of prepared by the specific processing of *Tricholoma Conglobatum* and pharmaceutically acceptable, classified in Class 424 or 514, subclasses depending upon the extract per se. It is noted that the claims must be dependent upon the process per se otherwise these claims would be considered unsearchable unless the structure of the specific terms are known structures.

- IX. Claims 27, 28, 29 drawn to a method of treating a disorder associated with pathological neovasularization or endothelial cell growth by using the extracts of prepared by the specific processing of *Tricholoma Conglobatum* and pharmaceutically acceptable with additional agent(s), classified in Class 424 or 514, subclasses depending upon the extract per se and the agent in the mixture. It is noted that the claims must be dependent upon the process per se otherwise these claims would be considered unsearchable unless the structure of the specific terms are known structures.
- X. Claim 34, drawn to a method of screening for a therapeutic agent with an extract selected from the group consisting of specific agents, classified in class 435, subclass 29+.
- XI. Claim 35, drawn to a method of screening which improperly depends upon a closed Markush grouping, classified in Class 435, subclass 29+.
- XII. Claim 36, drawn to a kit, cannot be properly classified as to the scope of the claimed species cannot be properly classified.

Absolutely no product will be obtained without knowledge of the structure per. Only products depending upon the processes will be considered-thus product by processes to be enabling. Any claim which is not dependent upon the process of making the product, Applicant will have a problem obtaining allowable subject matter which includes e.g., claims 22, 24 and 36.

4. The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be prepared by employing different process conditions.

Inventions II, IV and VI, VII, VIII, IX, X and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be employed for different processes as noted by the various processes as claimed.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention, thusly the restriction for examination purposes as indicated is proper.

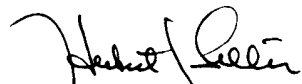
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is (703) 308-2034** and **Fax Number** is for applications **Before Final** (703) 872-9306 and **After Final** for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL  
(703) 308-2034  
Art Unit 1651  
June 12, 2003



Dr. Herbert J. Lilling  
Primary Examiner  
Group 1600 Art Unit 1651